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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,985	11/03/2000	Dirk M. Anderson	2874-B	6890

7590 03/26/2002

Immunex Corporation  
Law Department  
51 University Street  
Seattle, WA 98101

EXAMINER

BASI, NIRMAL SINGH

ART UNIT	PAPER NUMBER
1646	

DATE MAILED: 03/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. <b>09/705,985</b>	Applicant(s) <b>Anderson et al</b>
Examiner <b>Nirmal S. Basi</b>	Art Unit <b>1646</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Jul 23, 2001

2a)  This action is **FINAL**.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1-24 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 1-24 are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      20)  Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Amendments filed 11/3/00 and 7/30/01 have been entered as paper number 2 and 4, respectively.

2. **Please Note:** In an effort to enhance communication with our customers and reduce 5 processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-10 308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

#### ***Election/Restriction***

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-4, 17, 21 in so far as they encompass a method of inhibiting osteoclast 15 generation comprising using RANK polypeptide of SEQ ID NO:2, classified in class 514, subclass 2.

II. Claims 1-4, 17 in so far as they encompass a method of inhibiting osteoclast generation comprising using RANK polypeptide of SEQ ID NO:5, classified in class 514, 20 subclass 2.

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III. Claims 5-16, 18-20, 22-24 in so far as they encompass a method of ameliorating effects of excess bone loss comprising administering RANK polypeptide of SEQ ID NO:2, classified in classified in class 514, subclass 2..

VI. Claims 5-16, 18-20 in so far as they encompass a method of ameliorating effects 5 of excess bone loss comprising administering RANK polypeptide of SEQ ID NO:5, classified in classified in class 514, subclass 2.

The methods of Inventions I-IV are distinct from each other because they are independent, using separate method steps, active agents and having different effects.

Because these inventions are distinct for the reasons given above, restriction for 10 examination purposes as indicated is proper. A search of the art for Inventions I-IV would not be co-extensive with each other. Because the searches required for these inventions are not co-extensive an examination of the materially different, patentably distinct inventions in a single application would constitute a serious burden on the examiner.

Applicant is advised that the reply to this requirement to be complete must include an 15 election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

**Advisory Information**

5 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

10 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

15 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Nirmal S. Basi *N.S.B.*

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20 March 25, 2001

*MICHAEL PAK*  
MICHAEL PAK  
PRIMARY EXAMINER  
*MICHAEL PAK*  
MICHAEL PAK